

REMARKS

Claim 12 has been amended to correct the inadvertent reference to "motor" where the Applicant meant "roller". Claim 7, 16, and 24 were cancelled because the limitations in these claims were moved into their respective independent claims.

CLAIM REJECTIONS - 35 U.S.C. § 102(b)

Independent claims 1, 11, and 18, as well as dependent claims 2, 4, 5, 14, 19, and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Karg (U.S. Patent No. 5,226,607). In view of the amendments to independent claims 1, 11, and 18, Applicant respectfully traverses these rejections and requests reconsideration of the claims.

Amended claims 1, 11, and 18 require that the outlet chute is spring loaded. Such spring loading of the outlet chute inhibits or reduces jams in the roller, as further provided in claims 11 and 18. Karg does not teach or disclose this limitation of a spring loaded outlet chute. The outlet chute of Karg is fixed or stationary. Therefore, a *prima facie* case of anticipation has not been made for independent claims 1, 11, and 18 as amended and thus also for dependent claims 2, 4, 5, 14, 19, and 20. Applicant respectfully requests that this rejection be withdrawn.

Furthermore, with respect to claims 4 and 20, Karg does not teach that the roller operates at a speed of approximately 60 rpm. Karg only discloses a speed of 50 rpm for the cutting roller 3. (Karg, column 3, lines 47-49; Karg claim 10).

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

Claims 3, 7-10, 12, 13, 16, 17, 21, 22, 24, and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Karg. Applicant has cancelled claims 7, 16, and 24, with the

limitations regarding the spring loaded or spring biased outlet chute being incorporated into independent claims 1, 11 and 18. Applicant respectfully traverses this rejection for the remaining claims and requests reconsideration of the remaining claims.

For a § 103(a) rejection, the prior art references must teach or suggest all the claim limitations. MPEP §§ 2142, 2143.03. However, the Examiner asserts that "biasing members to prevent jams are well known in the art." "Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of *instant* and *unquestionable* demonstration as being well known." MPEP § 2144.03(A) (emphasis added). To sustain this rejection, the Examiner must be able to produce "substantial evidence" that the spring loaded limitation in claims 1, 11 and 18 is well known in the art. *See* MPEP § 2144.03. Therefore, pursuant to MPEP § 2144.03, Applicant respectfully requests authority which shows that the spring loaded outlet chute limitation is well known in the art. The Court of Appeals for the Federal Circuit has clearly stated that obviousness cannot be based on "common knowledge and common sense of a person of ordinary skill in the art without a specific hint or suggestion in a particular reference." In re Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

This spring loaded chute limitation is not well known in the art because jamming is a problem in the mulching rollers of chipper-shredder machines. This problem has not been adequately solved in the art. If a biased spring loaded chute were common knowledge in the art for solving this problem, then there should be a readily ascertainable prior art reference that shows this limitation. Thus, a spring loaded chute for preventing clogging in the roller does not merely "fill in the gaps" of the Karg reference. *See* MPEP § 2144.03(E). In fact, Karg does not provide any teaching or motivation that would suggest a spring loaded outlet chute which helps

to reduce clogging in the roller. Therefore, the Karg reference in combination with what is asserted as common knowledge in the art fails to produce a *prima facie* case of obviousness of independent claims 1, 11 and 18.

Claims 8, 17 and 25 require an electric motor. Applicant's roller allows the use of an electric motor while still providing a high torque roller that can mulch larger branches. The electric motor drastically reduces noise in residential neighborhoods while the high torque, low speed roller increases operator safety since high speed knives and blades are not needed. Because of the desirable benefits that these limitations bestow to Applicant's chipper-shredder machine, if these limitations were obvious design choices or were well known in the art, there should be a readily ascertainable reference showing these limitations. For the foregoing reasons, Applicant respectfully requests that the obviousness rejection for claims 8, 17 and 25 be withdrawn. Applicant respectfully requests allowance of the claims.

Claims 6, 15, 23, and 26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Karg in view of Morey (U.S. Patent No. 5,137,219). Applicant respectfully traverses this rejection and requests reconsideration of the claims.

Claims 6, 15, 23 and 26 are directed towards a reversible motor for driving the roller of the chipper-shredder machine. The combination of Karg and Morey fails to disclose a chipper-shredder machine in which a reversible motor drives the chipping roller. Morey does not disclose a reversible motor that drives the chipping roller. Morey only discloses a reversible hydraulic motor that powers and turns the feed roll cylinder 56. (Morey, column 6, lines 21-58). The feed roll cylinder 56 only feeds the branches into the chipping disc 18. It is the chipping disc 18, not the feed roll cylinder, which does the chipping of the branches. (Morey, column 5, lines 16-47). Morey only discloses that the chipping disc is driven by a gasoline engine through a belt


and pulley system. (Morey, column 5, lines 3-15). Unlike Applicant's limitations, Morey does not disclose a chipping roller driven by a reversible motor. Thus, Applicant's chipper-shredder machine, with the chipping roller itself being driven by a reversible motor, is different from the Morey disclosure because Morey uses an extra hydraulically-driven feeding cylinder to back out clogged branches. Because the combination of Karg in view of Morey does not disclose all limitations of dependent claims 6, 15, 23, and 26, a *prima facie* case of obviousness has not been made. Therefore, Applicant respectfully requests withdrawal of this rejection and allowance of these claims.

In view of the foregoing remarks, reconsideration and allowance is respectfully requested for all pending claims.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,


KIRK M. HARTUNG, Reg. No. 31,021
McKEE, VOORHEES & SEASE, P.L.C.
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No: (515) 288-3667
Fax No: (515) 288-1338
CUSTOMER NO: 22885

Attorneys of Record

- pw -